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Serial No. 10/790,465

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PD-202096

REMARKSI. Introduction

In response to the Office Action dated August 10, 2006, claims 2-5, 8, 15-18, 21, 28-31 and 34 have been canceled, and claims 1, 6-7, 9-10, 12-14, 119-20, 22-27, 32-33 and 35-39 have been amended. Claims 1, 6-7, 9-14, 19-20, 22-27, 32-33 and 35-39 remain in the application. Re-examination and re-consideration of the application, as amended, is requested.

II. Telephone Interview Summary

Record is made of telephone interviews that occurred on November 3, 2006 and November 7, 2006 between Applicant's attorney George H. Gates (Reg. No. 33,500) and Examiner Lewis. The interview concerned the erroneous change in customer number, the erroneous claim to priority and the objections to the specification and drawings. Assignee's attorney George H. Gates thanks Examiner Lewis for her help in resolving these issues.

III. Erroneous Change in the Customer Number

Applicant's attorney notes that the law firm of Baker Botts apparently submitted correspondence in the instant application that changed the Customer Number. This was done in error. Baker Botts is not on the power of attorney in this application and does not have the authority to change the Customer Number. During the telephone interview on November 3, 2005, Applicant's attorney George H. Gates (Reg. No. 33,500) requested the Examiner's assistance in restoring the assignee's Customer Number 020991, which was accomplished.

IV. Erroneous Claim to Priority

On pages 2-3 of the Office Action, a number of issues were raised with regard to a certified copy of a German Patent Application DE 101 43 502.9 that was submitted in this application, apparently by the law firm of Baker Botts. This was done in error. There is no claim to priority in this application and German Patent Application DE 101 43 502.9 is not related to this application.

V. Drawing and Specification Objections

On pages 4-6 of the Office Action, the drawings were objected to as failing to comply with 37 C.F.R. §1.84(p)(5) because the reference numbers of figures 1-3 are not mentioned in the description, and the drawings were objected to as failing to comply with 37 C.F.R. §1.83(a) because

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figures 1-6 have not been provided, and only figures 1-3 have been provided. In addition, the specification was objected as not matching the drawings, because the specification discusses figures 1-6, but only figures 1-3 were submitted.

Applicant's attorney traverses this objection. Applicant's attorney accessed the Image File Wrapper of PAIR and determined that the application as filed on March 1, 2004, included the correct figures, which includes just Figures 1-3, and specification, which discusses the reference numbers of these figures. Consequently, Applicant's attorney requests withdrawal of these objections.

VI. Statutory Subject Matter Rejections

On pages 6-7, the Office Action rejects claims 1, 14 and 27 under 35 U.S.C. §101 as being directed to non-statutory subject matter because the claims do not produce a tangible result.

Applicant's attorney has amended the claims to overcome these rejections. However, should issues still remain in this regard, the Applicant's attorney requests that the Examiner indicate how the rejection can be overcome and how problems may be resolved, in accordance with the directives of the Examination Guidelines for Computer-Related Inventions. See Guidelines II M.P.E.P. § 2106. Specifically, should it be necessary, the Applicant's attorney requests that the Examiner identify features of the invention that would render the claimed subject matter statutory if recited in the claim. See Guidelines IV, M.P.E.P. § 2106.

VII. Non-Art Claim Rejections

On page 7, the Office Action rejects claims 1, 14 and 27 under 35 U.S.C. §112, second paragraph, as being indefinite due to the use of "obfuscating."

Applicant's attorney has amended the claims to overcome these rejections.

VIII. Prior Art Claim Rejections

On pages 7-9 of the Office Action, claims 1-39 were rejected under 35 U.S.C. § 102(e) as unpatentable over U.S. Publication 2003/0158960 (Engberg).

Applicant's attorney respectfully traverses this rejection.

Applicant's independent claims have been amended to recite that usage data is collected, stored and processed in accordance with a privacy policy. Specifically, both a customer identifier and the usage data are stored for "opt-in" customers, only a replacement identifier and the usage

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data are stored for "opt-neutral" customers, and neither the customer identifier, replacement identifier, nor the usage data are stored for "opt-out" customers.

Engberg does not teach or suggest these features of Applicant's claims. Indeed, the only portion of Engberg that refers to an "opt-out list" relates to email, not usage data. Nothing in Engberg refers to storing usage data, as well as a customer identifier or replacement identifier, based on whether the customer is an "opt-in" customer, "opt-neutral" customer, or "opt-out" customer. Moreover, nowhere does Engberg recognize the concepts of "opt-in" and "opt-neutral" customers.

Thus, Applicant's attorney submits that independent claims 1, 14 and 27 are patentable over the Engberg reference. Further, dependent claims 6-7, 9-13, 19-20, 22-26, 32-33 and 35-39 are submitted to be patentable over the Engberg reference in the same manner, because they are dependent on independent claims 1, 14 and 27, respectively, and thus contain all the limitations of the independent claims. In addition, dependent claims 6-7, 9-13, 19-20, 22-26, 32-33 and 35-39 recite additional novel elements not shown by the Engberg reference.

IX. Conclusion

In view of the above, it is submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephone interview, the Examiner is urged to call Applicant's undersigned attorney.

Respectfully submitted,

By 

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